

REMARKS

Claim Amendments

Claims 11-16, 54-59, 89, 90, 96, 97, and 101-104 are pending and under current examination. By this Amendment, Applicants have amended claims 11, 14, 54, 57, 89, 90, 96, and 97. No new matter has been added.

Office Action

In the Final Office Action, the Examiner took the following actions:

(a) rejected claims 11-15, 54-58, 89, 90, 96, and 97 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,285,777 ("*Kanevsky*") in view of U.S. Patent No. 5,422,821 ("*Allen*"); and

(b) rejected claims 16, 59, and 101-104 under 35 U.S.C. § 103(a) as being unpatentable over *Kanevsky* in view of *Allen* and further in view of Official Notice.

Applicants respectfully traverse these rejections and request reconsideration and withdrawal of these rejections.

Rejection of Claims 11-15, 54-58, 89, 90, 96, and 97 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 11-15, 54-59, 89, 90, 96, and 97 under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Kanevsky* in view of *Allen*. A *prima facie* case of obviousness has not been established with respect to these claims.

To establish a *prima facie* case of obviousness, the Final Office Action must, among other things, properly determine the scope and content of the prior art and properly ascertain the differences between the claimed invention and the prior art. See M.P.E.P. § 2144.08(II)(A). Furthermore, the Final Office Action must make findings with

respect to all of the claim limitations and must make “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” See M.P.E.P. §§ 2143.03 and 2141(III).

Amended independent claim 11 recites “[a] method for determining a standardized physical address of a user having an electronic account.” The method includes, among other things, the following elements:

sending, using a sending device, the address of the user to a static address database, the static address database using the address of the user and the standardized physical address of the user contained in a master address database to obtain a delivery point identification key from the master address database, wherein the standardized physical address conforms to a standard format;

receiving, using a receiving device, the delivery point identification key from the static address database, the delivery point identification key containing information specifying a storage location of the standardized physical address within the master address database; and

obtaining, using a second obtaining device, the standardized physical address from the master address database using the delivery point identification key.

According to amended independent claim 11, the “static address database [uses] . . . the address of the user and the standardized physical address of the user contained in a master address database to obtain a delivery point identification key from the master address database,” wherein “the delivery point identification key contain[s] information specifying a storage location of the standardized physical address within the master address database” (emphasis added).

In contrast, *Kanevsky* and *Allen*, whether taken alone or in combination, do not disclose at least the above elements of the claimed method for determining the standardized physical address.

The Final Office Action concedes that *Kanevsky* "does not disclose using the address of the user to obtain a delivery point identification key from a master address database, receiving, using a receiving device, a delivery point identification key from the static address database, the delivery point identification key containing information specifying a storage location of the standardized physical address within the master address database; and obtaining the standardized physical address from the master address database using the delivery point identification key." Final Office Action at p. 6.

The Final Office Action alleges that *Allen* cures the deficiencies of *Kanevsky*. This is incorrect. *Allen* discloses processing a destination address obtained from a mailpiece in the USPS ZIP+4 database "to determine the delivery point ZIP code for the mailpiece." *Allen*, col. 6:38-41. The delivery point ZIP code, which is comprised of the delivery point ZIP code and/or destination address, is then processed in the USPS National Change of Address (NCOA) database. *Allen*, col. 6:44-48. As a result of the processing, the system of *Allen* "checks the delivery point information against the list of former address for that delivery point." *Allen*, col. 6:55-56.

The Final Office Action alleges that the ZIP+4 database constitutes the claimed "static address database" and the NCOA database constitutes the claimed "master address database." Assuming, without conceding, this is true, *Allen* still fails to disclose a "delivery point identification key containing information specifying a storage location of the standardized physical address within the master address database," as recited by claim 11. The Final Office Action alleges that the delivery point information of *Allen* constitutes the claimed delivery point key. Final Office Action at p. 4. Applicants respectfully disagree.

The claimed delivery point identification key specifies a storage location within the master address database. The delivery point information of *Allen* identifies several addresses in the NCOA database, as demonstrated by the "list of former addresses" returned after processing the delivery point information. *Allen*, col. 6:55-56. Because the delivery point information of *Allen* identifies a plurality of addresses in the NCOA database it cannot constitute a "delivery point identification key containing information specifying a storage location of the standardized physical address," as recited by claim 11. A key that returns a list simply does not specify a storage location in a database.

Furthermore, *Allen* fails to disclose "the static address database using the address of the user and the standardized physical address of the user contained in a master address database to obtain a delivery point identification key from the master address database," as recited by claim 11. *Allen* discloses that the destination address obtained from the mailpiece is processed in the ZIP+4 database to determine the delivery point ZIP code for the mailpiece. Thus, using the logic of the Final Office Action, *Allen* discloses using the alleged user address to obtain the alleged delivery point identification key from the alleged static address database.

However, claim 11 recites a "static address database using the address of the user and the standardized physical address of the user contained in a master address database to obtain a delivery point identification key from the master address database." (emphasis added). All words in a claim must be considered in judging the patentability of that claim against the prior art. M.P.E.P. § 2143.03. Because *Allen*, using the Final Office Action's interpretation, discloses obtaining the delivery point identification key from the static address database, *Allen* fails to disclose or suggest

obtaining the delivery point identification key from the master address database by using the user address and the standardized physical address of the user contained in the master address database. The ZIP+4 database simply cannot constitute both the claimed static address database and the claimed master address database.

For at least these reasons, *Allen* fails to teach or suggest "the static address database using the address of the user and the standardized physical address of the user contained in a master address database to obtain a delivery point identification key from the master address database," as recited by claim 11.

In view of the above, the Final Office Action has neither properly determined the scope and content of the prior art nor ascertained the differences between the claimed invention and the prior art. Moreover, the Final Office Action has provided no motivation for one of ordinary skill in the art to modify the teachings of the prior art to achieve the claimed combinations. Accordingly, no reason has been articulated as to why one of skill in the art would find the claimed combination obvious in view of the prior art. For at least this reason, no *prima facie* case of obviousness has been established. The rejection of claim 11 under 35 U.S.C. § 103(a) as being obvious from *Kanevsky* in view of *Allen* is thus improper and should be withdrawn.

Although of different scope, independent claims 14, 54, 57, 89, 90, 96, and 97 recite elements similar to those discussed above in connection with claim 11. Therefore, independent claims 14, 54, 57, 89, 90, 96, and 97 are allowable for at least the same reasons discussed above with respect to claim 11. In addition, dependent claims 12, 13, 15, 55, 56, and 58 are allowable at least by virtue of their dependence from independent claims 11, 14, 54, and 57, as well as by their recitation of additional

elements not taught or suggested by the cited references. Applicants therefore respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of claims 11-15, 54-58, 89, 90, 96, and 97.

Rejection of Claims 16, 59, and 101-104 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 16, 59, and 101-104 under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Kanevsky* in view of *Allen* and Official Notice. Notwithstanding the Final Office Action's allegations, dependent claims 16, 59, and 101-104 are allowable over the cited references at least by virtue of their dependence from independent claims 11, 14, 54, and 57, as well as by virtue of their recitation of additional elements not taught or suggested by the cited references. Moreover, the alleged Official Notice does not compensate for the deficiencies of *Kanevsky* and *Allen* discussed above. Applicants therefore respectfully request withdrawal of the § 103(a) rejection of claims 16, 59, and 101-104.

Conclusion

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of this application, and timely allowance of the pending claims.

The Final Office Action contains statements characterizing the related art and the claims. Regardless of whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the Final Office Action.

Please grant any additional extensions of time required to enter this response
and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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